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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,460	01/30/2001	Timothy Alexander Gordon	14244	7156
7590 04/07/2006 Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			EXAMINER TRAN, ELLEN C	
			ART UNIT 2134	PAPER NUMBER

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/772,460

Applicant(s)

GORDON ET AL.

Examiner

Ellen C. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to communication: amendment filed 28 December 2005, with an original application filed 30 January 2001, and with acknowledgement of foreign application date of 26 September 2000.

2. Claims 23-62 are currently pending in this application. Claims 23 and 38 have been amended. Claims 61 and 62 are new. Claims 23 and 43 are independent claims. Amendment to the claims is accepted.

***Response to Arguments***

3. Applicant's arguments with respect to claims 23-62 have been considered but are moot due to new grounds of rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 23-30, 32-48, and 50-62, are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcorn et al. U.S. Patent No. 6,149,522 (hereinafter '522) in view of Hansmann et al. US Patent No. 6,892,301 (hereinafter '301).**

**As to independent claim 43, "A method for securely downloading information to a gaming terminal" is taught in '522 col. 3, lines 37-43;**

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**“comprising: transmitting a second encrypted electronic information from a host device; receiving the second encrypted electronic information at the gaming terminal”** is shown in ‘522 col. 11, lines 3-29;

**“and replacing a first resident electronic information at the gaming terminal with the second decrypted electronic information”** is shown in ‘522 col. 12, lines 58-63; the following is not taught in ‘552:

**“receiving at the gaming terminal a second non-resident security key separately from a first resident security key and the second encrypted electronic information”** however ‘892 teaches “In order to solve the above objects and to avoid the above-mentioned drawbacks of existing mechanisms and systems, the invention proposes that the information unit is provided from the issuer to the first information processing device whereby the information unit is processed by a cryptographic process i.e. for instance encrypted and/or signed by a signature. The required key for the cryptographic process is particularly provided on the second secure information processing device ... It is emphasized that the information unit can be secured by alternatively using encryption/decryption and signature verification or by using both mechanisms in parallel” in col. 4, lines 43-56;

**“decrypting the second encrypted electronic information into a second decrypted electronic information at the gaming terminal with at least the first resident security key and the second non-resident security key;”** however ‘301 teaches “The information unit is cryptographically reprocessed i.e. for example decrypted and/or its signature verified by using the key” in col. 4, lines 43-56;

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of '522 a method of loading new or modified games into a game terminal to include a means to encrypt and decrypt of the game operation code with addition secret keys provided at the time of download. One of ordinary skill in the art would have been motivated to perform such a modification to support modifications to terminal devices that have a missing software component (see '301 col. 3, line 61 through col. 4, line 42). "A particular scenario for the present invention is a situation where a chip card is inserted in a chip card acceptance device--in the following called "terminal device"--which does not yet have a support module capable of accessing the card or to fulfill a particular function of the chip card on the terminal. Therefore it is required to obtain the missing software component from an other source of information e.g. to download such required module from a central server connected to the internet. It is noted that the terminal device can either be a computer, like a personal computer or network computer with a chip card reader/writer hardware, or a specialized device combining the chip card reader/writer hardware with an embedded computer ... The transmission will often take place over a network that is open to attacks. It is known that the chip card hereby ensures that the software component in the device accessing the chip card shares a secret to the chip card by using mechanisms ... It is therefore an object of the present invention to provide a method and a system for securely interoperating a first information processing device ... in a secure manner".

**As to dependent claim 44, "wherein the transmitting the second encrypted electronic information and receiving the second encrypted electronic information occurs over a communications link" is disclosed in '522 col. 11, lines 16-23.**

**As to dependent claim 45, “wherein the communication link comprises a cable coupled to parallel ports of the host device and the receiving component” is taught in ‘522 col. 7, lines 35-46.**

**As to dependent claim 46, “wherein the communications link comprises a secure network” is shown in ‘522 col. 2, lines 47-65.**

**As to dependent claim 47, “wherein the communications link comprises a wide area Ethernet network” is disclosed in ‘522 col. 7, lines 35-46.**

**As to dependent claim 48, “wherein the transmitting is accomplished with a physical electronic key removably attached to the gaming terminal” is taught in ‘522 col. 10, lines 28-33.**

**As to dependent claim 50, “further comprising determining a version information of the second encrypted electronic information with an information in the second non-resident security key” is disclosed in ‘522 col. 12, lines 52-62 and col. 9, lines 17-40.**

**As to dependent claim 51, “further comprising storing the second decrypted electronic information in the gaming; terminal in a nonvolatile memory” is taught in ‘522 col. 9, lines 41-50.**

**As to dependent claim 52, “wherein the second decrypted information comprises game application code” is shown in ‘522 col. 12, lines 52-62.**

**As to dependent claim 53, “wherein the second decrypted information comprises game system modules” is disclosed in ‘522 col. 12, lines 52-62.**

**As to dependent claim 54, “wherein the second decrypted information comprises game graphics and audio files” is taught in ‘522 col. 7, line 65 through col. 8, line 14.**

**As to dependent claim 55, “wherein the second decrypted information comprises new release game software files”** is shown in ‘522 col. 12, line 52-62.

**As to dependent claim 56, “further comprising: transmitting a third encrypted electronic information from the host device; receiving the third encrypted electronic information at the gaming terminal”** is shown in ‘301 col. 5, lines 29-36 “It is noteworthy that the information unit can be any set of (pure) data or an executable code like an application program or a hardware driver to run on the second secure device and/or the other device(s), i.e. any kind of information. Further the information unit can serve to run specific functions of the second secure device on the first device or on at least a third device attached to the first device.”;

**“receiving a third non-resident security key with the second encrypted electronic information at the gaming terminal”** is disclosed in ‘522 col. 12, lines 6-32;

**“decrypting the third encrypted electronic information into a third decrypted electronic information at the gaming terminal with at least the first resident security key and the third non-resident security key”** is taught in ‘522 col. 12, lines 33-53;

**“and replacing the second decrypted electronic information with the third decrypted electronic information”** is shown in ‘522 col. 12, lines 58-63.

**As to dependent claim 57, “further comprising packaging the third non-resident security key and the second encrypted electronic information into one file”** is taught in ‘522 col. 4, lines 43-67 (note the packaging numbers, i.e. first, second, third are interpreted to have the same meaning as the preparation phase for any numbered update or modification, in addition the packaging into one file is interpreted to mean packaging into a memory device).

**As to dependent claim 58, “wherein the host device is local to the gaming terminal”** is shown in ‘522 col. 2, lines 37-46.

**As to dependent claim 59, “wherein the host device is in the same geographic location to the gaming terminal”** is disclosed in ‘522 col. 2, lines 46-56.

**As to dependent claim 60, “wherein the host device is remote from the gaming terminal”** is taught in ‘522 col. 2, lines 46-56.

**As to independent claim 23**, this claim is directed to an electronic downloading system of the method of claim 46; therefore it is rejected along the same rationale.

**As to dependent claims 24-30 and 32-42**, these claims incorporate substantially similar subject matter as claims 44-48, and 50-60; therefore they are rejected along similar rationale.

6. **Claims 31 and 49**, are rejected under 35 U.S.C. 102(e) as being anticipated by Alcorn et al. U.S. Patent No. 6,149,522 (hereinafter ‘522) in view of Hansmann et al. US Patent No. 6,892,301 (hereinafter ‘301) in further view of Elliot U.S. Patent No. 6,468,160 (hereinafter ‘160).

**As to dependent claim 49**, the following is not taught in the combination of ‘544 and ‘301: **“further comprising decrypting an encrypted master reset component in the gaming terminal with the second non-resident security key”** however ‘160 teaches “As is described in more detail in application Ser. No. 08/562,288, serial peripheral interface 138 also includes a “boot ROM (read only memory)” that stores a small amount of initial program load (IPL) code. This IPL code stored within the peripheral interface boot ROM is executed by main processor 100 at time of startup and/or reset to allow the main processor to begin executing game program instructions 108 within storage device 54. The initial game program instructions 108 may, in



turn, control main processor 100 to initialize the drivers and controllers it needs to access main memory 300” in col. 10, lines 45-56.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of '522 and '301 a method of loading new or modified games into a game terminal by encrypting the game operation code to include a reset key to improve security. One of ordinary skill in the art would have been motivated to perform such a modification because over the years gaming system need the protection of a multilevel security system (see '160 col. 2, lines 23 et seq.). “The present exemplary embodiment focuses security control in a disk drive/mass media controlling engine which is physically disposed within the expansion device housing as close as possible to the hard disk drive and the downloaded video games and other data it is designed to protect. Security features are incorporated into, for example, a disk drive controlling processing engine to provide security features which extend far beyond simplistic password systems which have heretofore been utilized in conjunction with disk drive controllers”.

**As to dependent claim 31**, this claim incorporates substantially similar subject matter as claims 49; therefore it is rejected along similar rationale.

7. **Claims 61 and 62**, are rejected under 35 U.S.C. 102(e) as being anticipated by Alcorn et al. U.S. Patent No. 6,149,522 (hereinafter '522) in view of Hansmann et al. US Patent No. 6,892,301 (hereinafter '301) in further view of Ahrens et al. U.S. Patent No. 6,018,695 (hereinafter '695).

**As to dependent claim 62**, “with the first resident security key at the gaming terminal, and decrypting the interim result into the second decrypted electronic

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**information with the second non-resident security key at the gaming terminal”** is disclosed in ‘522 col. 12, lines 58-63;

the following is not taught in the combination of ‘522 and ‘301: **“wherein the decrypting the second encrypted electronic information into a second decrypted electronic information further comprises decrypting the second encrypted electronic information into an interim result”** however ‘695 teaches “To achieve the foregoing and other objectives and in accordance with the purposes of the present invention, there is provided an improved method and system that provides for distributing data for storage media, and in particular, the present invention provides for the updating and/or upgrading of data, such as geographical data and navigation application programs, used in in-vehicle navigation systems ... Subscriptions for obtaining updated navigation data would be available to owners of in-vehicle navigation systems entitling them to obtain updated navigation data from the local repositories. Procedures for updating the local repositories are also provided. The system and method can be used for updating other types of data and/or software” in col. 2, line 50 through col. 3, line 3.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of ‘522 and ‘a method of loading new or modified games into a game terminal by encrypting the game operation code to include a means to store interim software to be loaded. One of ordinary skill in the art would have been motivated to perform such a modification because a means to permit updating of software is needed (see ‘695 col. 2, lines 45 et seq. and col. 22, lines 49 et seq.). “Further, more generally, there is a need for a system that permits the updating of consumer software products, as needed” and “The embodiments of the system described above are particularly useful for distributing updated geographical data

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sets for in-vehicle navigation systems used in automobiles. However, the system could also be used to update other types of software or data, including software for personal computers, computer game storage devices, etc. Distribution of updated geographical data may also be used in application programs used for fleet distribution and marketing. Further, although the systems described above are described as being useful for land-based vehicles, they could be used in other-than-land-based vehicles as well, such as boats and aircraft”.

**As to dependent claim 61**, this claim incorporates substantially similar subject matter as claims 62; therefore it is rejected along similar rationale.

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:00 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques H. Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*ECT* **Ellen. Tran/Patent Examiner**  
**Technology Center 2134/31 March 2006**

*Jacques H. Louis-Jacques*  
**JACQUES H. LOUIS-JACQUES**  
**EXAMINER**